

Remarks

The Rejection of Claims 1, 2, and 5-11 under United States Patent No. 103 (a)

The Examiner rejected Claims 1, 2, and 5-11 as unpatentable under 35 U.S.C. § 103 (a) as obvious over United States Patent No. 6,650,703 to Schwarzmann, et al. ("the '703 patent") in view of PCT Publication WO 98/0199 to Clinch ("Clinch" or "the Clinch application"). Applicant respectfully traverses the rejection of these claims and requests reconsideration.

To establish a *prima facie* case of obviousness there must be some suggestion or motivation to modify the reference. In addition, the reference, or combination of references, must teach or suggest all limitations of the claim at issue. The teaching or suggestion to make the combined combination must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir.1991). Applicant respectfully submits that the combination of the '703 patent and the Clinch application fails to disclose each limitation of independent Claim 1 and therefore fail to render Claim 1 obvious under § 103 (a).

Applicant courteously points out that step e in Claim 1 recites only the recording of a second complete image that, as seen in the instant specification, is offset from the first complete image. However, in the instant invention, unlike the step cited in the '703 patent, that second complete image is not outputted as the first complete image is in step d. As described in Paragraph 0022 of the instant application, the second complete image is recorded and transferred to a coding element 26. However, that complete second image is used only to generate a partial image that correlates with the offset part of the second complete image. It is the first complete image and the partial image, plus position data for the partial image that is outputted to a decoder. See Paragraphs 0027 and 0028 describing the transfer of the coded first complete image and the coded partial image and their combination in an image assembler to form a new decoded image that includes the offset portion formed from the partial image. It is this new decoded image that is output onto an output medium such as a monitor.

In contrast, the '703 patent discloses a method in which a first image is a fresh image areas, presumably analogous to the portion or partial image of the instant invention. As

described in the '703 patent, the transmitted image areas are joined to the existing image, which was first correspondingly shifted. (See '703 patent - col. 9, lines 16-19. Emphasis added.) Thus, the method of the '703 patent comprises the transfer of a series of partial images to the monitor of the observation station. In contrast, the method of the instant invention comprises the transfer of a series of joined complete images to the output monitor which includes the offset portion of the newest image with the common portion of the previous image. The common portion comprises those portions of the newest and previous images that have common image data. Therefore, the method of image transfer claimed in Claim 1 differs from that of the '703 patent.

The method of image transfer in Clinch differs from both the instant invention and that of the '703 patent. Clinch employs two buffer units. The second buffer unit receives a new partial image from a moving camera and places the new partial image at the leading edge of the received image while simultaneously sending the trailing edge of the image to the first buffer unit. The first buffer unit places this trailing edge image at the leading edge of its own stored image and discards the trailing edge of that image. It can be seen that the Clinch application and the '703 patent, either separately or in combination, does not disclose the method of the instant application which claims the transfer of a series of complete images

As noted above, in order to establish a *prima facie* case of obviousness, the combined references must disclose all the limitations of the rejected claim. As seen from the discussion above, neither the '703 patent nor the Clinch application disclose the invention as claimed in independent Claim 1. The '703 patent discloses the transfer of a series of partial images to an output monitor while the instant invention discloses the transfer of a series of complete images to an output monitor. The Clinch application discloses using two buffer units to add a leading edge of an image in one buffer memory and discard the trailing edge of an image in a second buffer memory. Neither separately nor together do the '703 patent or the Clinch application disclose, teach or suggest the transfer of a series of complete images to an output monitor. For this reason, Applicant respectfully traverses the rejection of Claim 1 and requests reconsideration.

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Reply to Office Action of August 12, 2004
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“If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 2-11 depend directly or indirectly from Claim 1 and thus incorporate all the elements of that claim. Because, as seen above, Claim 1 is not rendered obvious by the combination of the ‘703 patent and the Clinch application, Claims 2-11 are also not rendered obvious by the same combination of references. For this reason Applicant respectfully traverses the rejection of Claims 2-11 and requests reconsideration.

The Objections to Claims 3 and 4

The Examiner stated that Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim. As seen from the discussion, Claim 1, from which Claims 3 and 4 depend, is not rendered obvious under § 103 (a) over the ‘703 patent in view of the Clinch application. Applicant respectfully traverses the objections to Claims 3 and 4 and requests reconsideration.

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Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,



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